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| EXAMINER | |
|---|---|
| CHOUDHURY, AZIZUL Q | |
| ART UNIT | PAPER NUMBER |
| 2453 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/833,173 | SPURGAT ET AL. | |
| | Examiner | Art Unit | |
| | AZIZUL CHOUDHURY | 2453 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 September 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *10-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/28/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## *Detailed Action*

This office action is in response to the correspondence received on September 8, 2010.

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US Patent No: 6,697,944) in view of Levy (US Patent No: 7,055,034), hereafter referred to as Jones and Levy, respectively.

1. With regards to claim 10, Jones teaches through Levy, a system for maintaining protection of digital content distributed for playback, the system comprising: a computing platform, executing a playback application, configured to: receive a playback command from a user to playback the digital content *(Jones teaches*

*how the user selects song for download and playback; see column 8, lines 48-59, Jones)*; select a server located on the Internet as a source of the digital content *(see column 8, lines 50-54, Jones)*; receive encrypted digital content from the server *(Jones teaches downloading the audio file from the server to the user's computer; see column 8, lines 50-54, Jones)*; forward the encrypted digital content without decrypting to a communication link *(see Levy below)*; a peripheral device coupled to the communication link and configured to: receive the encrypted digital content from the computing platform *(Jones teaches the portable device receiving the audio file from the PC; see column 10, lines 9-11, Jones)*; decrypt the encrypted digital content into decrypted digital content; and convert the decrypted digital content to analog content for playback *(Jones teaches the portable device decrypting the audio file for playback; see column 10, lines 37-39, Jones)*.

*While Jones teaches passing an encrypted audio file from a server to a pc to a portable device, Jones does not explicitly teach the portable device being the only device being able to decrypt the said file. In the same field of endeavor, Levy also teaches a method for encrypted file delivery. Within Levy's disclosure, it is taught how mp3 files are passed to a pc-based portable mp3 player via the Internet; see column 11, lines 60-63, Levy. The mp3 file is encrypted; see column 11, line 65 – column 12, line 2, Levy. Levy then teaches how the portable mp3 player is the only device able to decrypt the encrypted mp3 file; see column 12, lines 4-6, Levy. Restricting which devices can play an encrypted file*

*prevents the pirating of audio files. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Levy, to improve the robustness of data to duplication and unlocking; see column 2, lines 6-9, Levy.*

2. With regards to claims 11, 17 and 22, Jones teaches through Levy, the system wherein the command is received from the user at a graphical user interface of the executing playback application *(see column 8, lines 40-51, Jones)*.

3. With regards to claims 12, 18 and 23, Jones teaches through Levy, the system wherein the communication link is one of a USB bus, a PCI bus, or a FireWire bus *(see at least column 4, lines 5-8, Jones)*.

4. With regards to claims 13, 19 and 24, Jones teaches through Levy, the system wherein the peripheral device is further configured to: receive a status request from the computing platform over the communication link; and send status information to the computing platform over the communication link in response to the received status request *(Implicit protocol for USB connections. Also see column 4, line 44-60, Jones)*.

5. With regards to claim 14, Jones teaches through Levy, the system wherein the computing platform is further configured to: receive the status information, and

forward the encrypted digital content when the status information indicates the peripheral device is ready to process more data *(Implicit protocol for USB connections. Also see column 4, line 44-60, Jones)*.

6. With regards to claims 15, 20 and 25, Jones teaches through Levy, the system wherein the encrypted content is one of streamed encrypted content or stored encrypted content *(see at least column 7, lines 5-19, Jones)*.

7. With regards to claims 16 and 21, Jones teaches through Levy, a method for maintaining protection of digital content distributed for playback, the method comprising: receiving encrypted digital content from a computing platform, the computing platform having received a playback command from a user to playback the digital content and selected a server as a source of the digital content *(Jones teaches how the user selects song for download and playback; see column 8, lines 48-59, Jones)*, the computing platform having further received the encrypted digital content from the server and forwarded the encrypted digital content without decrypting the same *(Jones teaches the PC receiving encrypted audio files from a server; see column 8, lines 48-59, Jones. The portable device then receives the encrypted audio file from the PC; see column 10, lines 9-11, Jones)*; decrypting the encrypted digital content into decrypted digital content at a peripheral device; and converting the decrypted

digital content to analog content for playback *(Jones teaches the portable device decrypting the audio file for playback; see column 10, lines 37-39, Jones)*.

*While Jones teaches passing an encrypted audio file from a server to a pc to a portable device, Jones does not explicitly teach the portable device being the only device being able to decrypt the said file. In the same field of endeavor, Levy also teaches a method for encrypted file delivery. Within Levy's disclosure, it is taught how mp3 files are passed to a pc-based portable mp3 player via the Internet; see column 11, lines 60-63, Levy. The mp3 file is encrypted; see column 11, line 65 – column 12, line 2, Levy. Levy then teaches how the portable mp3 player is the only device able to decrypt the encrypted mp3 file; see column 12, lines 4-6, Levy. Restricting which devices can play an encrypted file prevents the pirating of audio files. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Levy, to improve the robustness of data to duplication and unlocking; see column 2, lines 6-9, Levy.*

8. With regards to claim 26, Jones teaches through Levy, a method for maintaining protection of digital content distributed for playback, the method comprising: receiving a status request at a peripheral device from a computing platform *(Implicitly part of USB and Jones supports use of USB; see column 4, lines 5-8. Also see column 4, line 44-60, Jones)*; sending status information to the computing platform in response to the received status request, the status

information indicating that the peripheral device is ready to process data *(Implicitly part of USB and Jones supports use of USB; see column 4, lines 5-8. Also see column 4, line 44-60, Jones)*; receiving encrypted digital content over a peripheral bus from the computing platform, the computing platform having received a playback command from a user to playback the digital content *(Jones teaches how the user selects song for download and playback; see column 8, lines 48-59, Jones)* at a graphical user interface of a playback application executing on the computing platform and selected a server as a source of the digital content, the computing platform having further received the encrypted digital content from the server over the Internet and forwarded the encrypted digital content on the peripheral bus without decrypting the same, wherein the encrypted content is one of streamed encrypted content or stored encrypted content *(Jones teaches the PC receiving encrypted audio files from a server over the Internet; see column 8, lines 48-59, Jones. The portable device then receives the encrypted audio file from the PC; see column 10, lines 9-11, Jones)*; decrypting the encrypted digital content into decrypted digital content at a peripheral device; and converting the decrypted digital content to analog content for playback. *(Jones teaches the portable device decrypting the audio file for playback; see column 10, lines 37-39, Jones)*.

*While Jones teaches passing an encrypted audio file from a server to a pc to a portable device, Jones does not explicitly teach the portable device being the only device being able to decrypt the said file. In the same field of endeavor,*

*Levy also teaches a method for encrypted file delivery. Within Levy's disclosure, it is taught how mp3 files are passed to a pc-based portable mp3 player via the Internet; see column 11, lines 60-63, Levy. The mp3 file is encrypted; see column 11, line 65 – column 12, line 2, Levy. Levy then teaches how the portable mp3 player is the only device able to decrypt the encrypted mp3 file; see column 12, lines 4-6, Levy. Restricting which devices can play an encrypted file prevents the pirating of audio files. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Levy, to improve the robustness of data to duplication and unlocking; see column 2, lines 6-9, Levy.*

### ***Response to Arguments***

Applicant's arguments filed September 8, 2010 have been fully considered but they are not persuasive. The following are the examiner's response to the applicant's arguments.

The principle argument contended by the applicant continues to concern the claimed feature of receiving from a server, encrypted digital content by a computing platform and then forwarding, without decrypting, the content to a portable device. The applicant contends that neither Jones nor Levy taught such a feature. Jones teaches the PC receiving encrypted audio files from a server over the Internet; see column 8, lines 48-59, Jones. The portable device then receives the encrypted audio file from the PC; see column 10, lines 9-11, Jones. However, Jones does not explicitly teach the

portable device being the only device being able to decrypt the said file. In the same field of endeavor though, Levy also teaches a method for encrypted file delivery. Within Levy's disclosure, it is taught how mp3 files are passed to a pc-based portable mp3 player via the Internet; see column 11, lines 60-63, Levy. The mp3 file is encrypted; see column 11, line 65 – column 12, line 2, Levy. Levy then teaches how the portable mp3 player is the only device able to decrypt the encrypted mp3 file; see column 12, lines 4-6, Levy. Thus, the encrypted file is transferred, without decryption, to the portable device.

The secondary argument focuses on the motivation to combine. The applicant contends that the two references cannot be combined. In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, both Jones and Levy teach networks that deliver encrypted files. Jones does not explicitly teach the portable device being the only device being able to decrypt the said file. But within Levy's disclosure, it is taught how mp3 files are passed to a pc-based portable mp3 player via the Internet; see column 11, lines 60-63, Levy. Levy then teaches how the portable mp3 player is the

only device able to decrypt the encrypted mp3 file; see column 12, lines 4-6, Levy. Restricting which devices can play an encrypted file prevents the pirating of audio files. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Jones with those of Levy, to improve the robustness of data to duplication and unlocking; see column 2, lines 6-9, Levy.

## *Conclusion*

Applicant's amendment necessitated the new grounds of rejection in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele can be reached on (571) 272-7288. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./
Examiner, Art Unit 2453

/Krista M. Zele/
Supervisory Patent Examiner, Art Unit 2453